IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

In re Patent Application of:	
Robert S. **OSCAR**, *et al.*	Group Art Unit: 3626
Serial No. 09/811,769	Examiner: PORTER, Rachel L.
Filed: March 20, 2001	Confirmation No. 9298
For: PHARMACY BENEFITS MANAGEMENT METHOD AND APPARATUS	Date: December 9, 2008

RESPONSE TO NOTICE OF NONCOMPLIANT APPEAL BRIEF AND AMENDED APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed November 26, 2008, Appellants submit the following Amended Appeal Brief in support of the appeal proceedings instituted by a Notice of Appeal filed on July 3, 2008, and in response to the Final Office Action mailed April 3, 2008, in connection with the above-captioned patent application.

Appellants note that the reason for noncompliance indicated on the "Notification of Non-Compliant Appeal Brief" form was that the claims appendix included claims which have been withdrawn from consideration. However, 37 CFR § 41.37(c)(1)(viii) does not require Appellants to list only those claims that are on appeal, but rather requires that the claims appendix contain "... a copy of the claims involved in the appeal." The original Appeal Brief filed on September 3, 2008, contained a claims appendix containing a copy of the claims

involved in the appeal in accordance with 37 CFR § 41.37(c)(1)(viii). Appellants repeatedly attempted to contact the Examiner and the SPE by telephone between December 1, 2008 and December 9, 2008, requesting clarification of this matter but were unable to make contact with either Examiner. As such, in the Amended Appeal Brief that follows, Appellants removed the withdrawn claims from the Appendix of Claims. All other sections of the Amended Appeal Brief are identical to the Appeal Brief filed on September 3, 2008.

I. REAL PARTY IN INTEREST

RxEOB.COM LLC is the assignee and real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are presently no appeals or interferences known to the Appellants, the Appellants' representative, or the assignee, which will directly affect or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

For the purposes of this Appeal, claims 14-18, 23-31, 36-39, and 49-55 are pending. Claims 1-13, 19-22, 32-35, and 40-48 were previously withdrawn in response to a Restriction Requirement. This Appeal is taken from the rejection of claims 14-18, 23-31, 36-39, and 49-55 in the Final Office Action mailed on April 3, 2008, and as set forth in the Claims Appendix submitted with this Appeal Brief.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been entered subsequent to the Final Office Action mailed April 3, 2008.

V. SUMMARY OF CLAIMED SUBJECT MATTER

This Appeal is taken from the rejection of claims 14-18, 23-31, 36-39, and 49-55 as presented in the Amendment filed on July 11, 2006, and the Request for Reconsideration

filed August 15, 2007. Claims 14 and 27 are independent claims. The present invention is generally directed to a system and method for managing pharmacy benefits.

Independent claim 14 relates to a pharmacy benefits management system including pharmacy benefits means, management means, and provider means. See Figure 1 and paragraphs [0016, 0017, 0042-0045]. Pharmacy benefits means receives claim information relating to pharmacy benefits claims processed by a claims processing facility, where the claim information includes identification of drugs dispensed to patients. See reference numeral 120 (pharmacy benefit manager server) in Figure 1 and the accompanying description in paragraphs [0042-0045, 0053, 0054]. Claim information is discussed throughout the Specification, including in paragraphs [009-0011, 0017, 0045-0047, 0053-0058, 0063] and in Figures 1 and 12.

Management means receive pharmacy benefits formulary information and price information relating to drugs in various classes. See reference numerals 110 (management server), 122 (formulary information), 124 (benefit information) regarding information in Figures 1, 2, 10A and paragraphs [009-0011, 0042-0047, 0053, 0065]. The management means also calculate out-of-pocket costs, 258 sponsor costs, 252 and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information. See Figures 2, 7, 8, 14, 15 and paragraphs [0051, 0053, 0054, 0056, 0058, and 0061-0066].

Likewise, the management means aggregate the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the identity of drug dispensed, the type of drug dispensed, formulary information, the identity of pharmacy dispensing drug, or the identity of doctor prescribing drug. See Figures 2, 7, 8, 14, 15 and paragraphs [0051,

0053, 0054, 0056, 0058, and 0061-0066]. The management means cause the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits.

Claim 14 also recites provider means included in the pharmacy benefits management system. Provider means receive pharmacy benefits plan structure information 134 including deductible information and co-payment information to determine a recipient's prescription benefit plan and to identify the subscriber of the prescription benefit plan. See reference numerals 258, 262 for price information and Figure 8. See also benefit information 124 in Figure 1 and benefit plan structure 134 in Figures 1, 10A, 10B, 15, 21, and 23, as well as the discussion in paragraphs [0010, 0016, 0044, 0053, 0054, 0060, 0064, and 0065].

Independent claim 27 relates to a method for managing pharmacy benefits including receiving claim information from a pharmacy benefits server, receiving pharmacy benefits formulary information from the pharmacy benefits server, receiving pharmacy benefits plan structure information from a provider server, receiving price information from a management server, determining a recipient's prescription benefit plan, identifying a subscriber of the recipient's prescription benefit plan, calculating out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients, aggregating the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients, and causing the aggregate out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits.

Claim 27 recites that the pharmacy benefits management method comprises receiving claim information from a pharmacy benefits server. See Figures 1 and 2 and paragraphs [0016, 0017, 0042-0046]. The claim information relates to pharmacy benefits claims processed by a claims processing facility, and the claim information includes identification of drugs dispensed to patients. See Figures 1 and 2 and the accompanying description in paragraphs [0042-0046, 0053, 0054]. Claim information is discussed throughout the

Specification, including in paragraphs [009-0011, 0017, 0045-0047, 0053-0058, 0063] and in Figures 1 and 12.

The method of claim 27 also recites receiving pharmacy benefits formulary information from the pharmacy benefits server. See reference numerals 110 (management server), 122 (formulary information), 124 (benefit information) regarding benefits formulary information in Figures 1, 2, 10A and paragraphs [009-0011, 0042-0047, 0053, 0065]. Additionally, the method of claim 27 includes receiving pharmacy benefits plan structure information from a provider server, the pharmacy benefits plan structure including deductible information and co-payment information. See paragraphs [0010, 0011, 0047, 0053-58, 0061-0063, and 0066].

Further, claim 27 recites receiving price information from a management server, the price information relating to drugs in various classes. See reference numerals 110 (management server), 122 (formulary information), 124 (benefit information) in Figures 1, 2, 7, 8, 10A, 10B, 15, 18, 21, and 23, and see paragraphs [0017, 0042-0047, 0050, 0051, and 0064]. The method of claim 27 also recites determining a recipient's prescription benefit plan. See paragraphs [0051, 0052] and Figures 3-5. Likewise, the method of claim 27 recites identifying a subscriber of the recipient's prescription benefit plan. See paragraphs [0051, 0061] and Figures 3-5.

In addition, claim 27 recites calculating out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information. See paragraphs [0050-0057, 0063] and Figures 2, 7, 8, 10A, 10B, 11, and 20. Similarly, claim 27 recites aggregating the out-of-pocket costs, sponsor costs, and total costs of the drugs

dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug. See Figures 2, 7, 8, 14, 15 and paragraphs [0051, 0053, 0054, 0056, 0058, and 0061-0066]. The method of claim 27 also includes causing a display of the aggregate out-of-pocket costs and sponsor costs to the recipient of prescription benefits.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. The first ground of rejection to be reviewed on appeal is the rejection of claims 14-18, claims 23-31, claims 36, 37, 52, and 55 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

B. The second ground of rejection to be reviewed on appeal is the rejection of claims 14-18 and claims 23-31 under 35 U.S.C. § 103(a) as being unpatentable over Pack-Harris U.S. Patent Number 6,195,612 in view of Mayaud U.S. Patent Number 5,845,255.

VII. ARGUMENTS

A. The Rejection of Claims 14-18, Claims 23-31, claims 36, 37, 52, and 55 under 35 U.S.C. § 112, first paragraph, as Failing to Comply with the Written Description Requirement should be REVERSED.

Claims 14-18, claims 23-31, claims 36, 37, 52, and 55 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement as indicated beginning on page 3 of the final Office Action mailed April 3, 2008. Appellants appeal this rejection and request reversal because the specification properly discloses a pharmacy benefits management system and a pharmacy benefits management method including the features of the system and method recited in independent claims 14 and 27.

The present invention relates to a system and method for managing pharmacy benefits. Independent claim 14 recites a pharmacy benefits management system that includes pharmacy benefits means for receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, management means for receiving pharmacy benefits formulary information and price information relating to drugs in various classes, and provider means for receiving pharmacy benefits plan structure information. See Figure 1 and paragraphs [0016, 0017, 0042-0045, 0053, and 0054].

The claim information recited in independent claim 14 includes identification of drugs dispensed to patients, and the pharmacy benefits plan structure information includes deductible information and co-payment information stored therein to determine a recipient's prescription benefit plan and identify the subscriber of the prescription benefit plan. See reference numeral 120 (pharmacy benefit manager server) in Figure 1 and the accompanying description in paragraphs [0042-0045, 0053, 0054]. Claim information is discussed throughout the Specification, including in paragraphs [009-0011, 0017, 0045-0047, 0053-0058, 0063] and in Figures 1 and 12. Additionally, the pharmacy benefits plan structure information includes deductible information and co-payment information stored therein to determine a recipient's prescription benefit plan and identify the subscriber of the prescription benefit plan. See reference numerals 258, 262 for price information and Figure 8. See also benefit information 124 in Figure 1 and benefit plan structure 134 in Figures 1, 10A, 10B, 15, 21, and 23, as well as the discussion in paragraphs [0010, 0016, 0044, 0053, 0054, 0060, 0064, and 0065].

Claim 14 also recites that the management means further calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim

information, the received formulary information, the received pharmacy benefits plan structure, and the received price information. See paragraphs [0050-0057, 0063] and Figures 2, 7, 8, 10A, 10B, 11, and 20.

Further, claim 14 also recites that the management means aggregates the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug; and causes the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits. See Figures 2, 7, 8, 14, 15 and paragraphs [0051, 0053, 0054, 0056, 0058, and 0061-0066].

In the Final Office Action mailed April 3, 2008, the Examiner asserts that claim 14 "recite[s] limitations that are new matter, and [is] therefore rejected. The respective depdedent [sic] claims inherit the deficiency through depedency [sic] and are therefore also rejected." See page 3, paragraph 4 of the Final Office Action mailed April 3, 2008. The Examiner goes on to assert that,

> The added material which is not supported by the original disclosure is as follows:
> calculates out of pocket costs (means for calculating), sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information; and
> aggregates (means for aggregating) the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug.

See pages 3-4 of the Final Office Action mailed April 3, 2008.

The Examiner further asserts, "In particular, the Applicant does not point to, nor was the Examiner able to find, any support for this newly added claim language within the specification as originally filed." See page 4 of the Final Office Action mailed April 3, 2008.

However, in Appellants' Amendment filed December 21, 2006, which amended independent claims 14 and 27 to include the above features, Appellants listed numerous sections of the original disclosure to support the claimed features of amended claims 14 and 27. To wit, "The features incorporated in the above amendments are disclosed at least in paragraphs [0016, 0045-0054] and throughout the specification." See page 21, paragraph 5 of Appellants' Amendment filed December 21, 2006. Specifically, paragraph [0050] of the present specification describes the completion of the registration process (Figure 2) and displaying a pharmacy benefits summary of the registered recipient. "The summary includes out of pocket costs 258 for the appropriate time period (such as the current calendar year) and sponsor costs 262 assumed by the plan sponsor for recipient's pharmacy benefits for that same time period." The disclosure in paragraph [0050] also notes, "... PBM server 120 includes benefit information 124 relating to pharmacy benefits, provided to recipients, such as the type of drug dispensed, the identity of the pharmacy dispensing the drug, the identity of the doctor dispensing the drug, and the like. Also, PBM server 120 includes formulary information 122. This information can be processed by management server 110 to present out of pocket costs 258 and sponsor costs 252." See paragraph 0[50] of the present application (emphasis added).

Additional details with regard to calculating costs are disclosed in the original specification in paragraphs [0051-0054] including:

> The screen illustrated in FIG. 8. provides a list of each drug dispensed to recipient (as an individual) under the pharmacy benefit plan in column 266 as well as the date of dispensing in column 272, the recipient's out of pocket costs (such as copayment) for that drug in column 274, and the plan sponsor costs in column 276. Once again, this information is culled from benefit information 124 stored in PBM server 120 and processed by management server 110 for presentation on recipient client 140.

See paragraph [0051] of the present specification (emphasis added).

In the April 3, 2008, Office Action, the Examiner also appears to impart additional limitations to the management means by listing additional "means" elements that are not recited in amended independent claim 14. For example, the Examiner appears to indicate that the management means that calculate out-of-pocket and other costs are "means for calculating" and that the management means that aggregate the out-of-pocket and other costs are "means for aggregating." This language is not recited in the amended claims pending in this application nor in the claims under appeal.

As described in at least paragraphs [0050-0054] of the present specification, there is proper support for a pharmacy benefits management system comprising pharmacy benefits means for receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients; management means for receiving pharmacy benefits formulary information and price information relating to drugs in various classes; provider means for receiving pharmacy benefits plan structure information including deductible information and co-payment information stored therein to determine a recipient's prescription benefit plan and identify the subscriber of the prescription benefit plan; and where said management means further calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information; aggregates the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug; and causes the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits.

Similarly, the specification provides proper support for independent method claim 27 that recites the steps performed in a method of managing pharmacy benefits using a pharmacy benefits

Therefore, there is ample support in the present specification to support claim 14, which recites a pharmacy benefits management system, well as claim 27, which recites a pharmacy management method performed using a system in accordance with claim 14. See paragraphs [0016, and 0050-0054] of the present specification.

Additionally, claims 15-18, 23-26, and 53-55 depend upon independent claim 14, while claims 28-31, 36, 37, and 52 depend upon independent claim 27 while reciting other features of the present invention. The Examiner asserted that these respective depedent [sic] claims inherit the deficiency through their depedency [sic]. As indicated above, the independent claims 14 and 27 are properly described in the original specification. Therefore, there is no deficiency to carry through to these dependent claims.

As such, Appellants respectfully submit that the claimed subject matter is properly described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Appellants respectfully request that the rejection of claims 14-18, 23-31, 36, 37, 52, and 55 under 35 U.S.C. § 112, first paragraph, be REVERSED.

B. The Rejection of Claims 14-18 and Claims 23-31 under 35 U.S.C. § 103(a) as being Unpatentable over Pack-Harris U.S. Patent Number 6,195,612 in view of Mayaud U.S. Patent Number 5,845,255 Should be REVERSED.

Claims 14-18 and claims 23-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pack-Harris U.S. Patent Number 6,195,612 ("the Pack-Harris patent") in view of Mayaud U.S. Patent Number 5,845,255 ("the Mayaud patent") as indicated beginning

on page 4 of the April 3, 2008, final Office Action. Appellants appeal this rejection and request reversal because the combination of the Pack-Harris patent and the Mayaud patent fails to disclose or suggest all the elements recited in the pending claims and fails to make the claimed invention unpatentable as obvious under 35 U.S.C. § 103(a).

The present invention generally relates to a pharmacy benefits management system and method. A processor server has claim information relating to pharmacy benefits claims, and information relating to a claims processing formulary stored therein. A provider server has pharmacy benefits plan structure information stored therein. A management server has price information relating drugs in various classes and a processing module for correlating the claim information with the benefits plan structure information and the formulary information to identify drugs dispensed to patients, expenses associated with the drugs in accordance with the pharmacy benefits plan structure information, alternative drugs in the same class as the drugs and expenses associated with the alternative drugs.

1. The Rejection of Independent Claim 14 under 35 U.S.C. § 103(a) should be REVERSED.

As outlined above, the present invention is generally directed to a pharmacy benefits management system and a method of managing pharmacy benefits by acquiring claim and benefit information and then processing and displaying aggregate out-of-pocket and sponsor costs to recipients of prescription benefits.

For example, independent claim 14 recites a pharmacy benefits management system comprising pharmacy benefits means for receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients. Claim 14 also recites that the pharmacy benefits management system includes management means for receiving pharmacy benefits formulary

information and price information relating to drugs in various classes; and provider means for receiving pharmacy benefits plan structure information including deductible information and co-payment information stored in the provider means to determine a recipient's prescription benefit plan and identify the subscriber of the prescription benefit plan. Claim 14 further recites that the management means further calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information. Additionally, claim 14 recites that the management means further aggregates the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug. Likewise, claim 14 recites that the management means causes the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits.

In contrast, the Pack-Harris patent appears to discuss a conventional pharmacy benefit management system to provide a medical group with costs and utilization rates by individual physicians and the group relative to pharmacy benefit capitation (see col. 2, lines 26-32 of the Pack-Harris patent). The system of the Pack-Harris patent provides a medical group with information regarding the drugs obtained, and their actual costs, based on the prescription activity of the medical group physicians (see col. 2, lines 33-38). This is quite different from the present invention, which is directed to providing pharmacy management information to the actual recipient consumer of the health care benefits to examine what is being charged with complete market transparency rather than to the person making the prescribing decision in a usage and activity environment as in the Pack-Harris patent.

The Examiner refers to column 5, lines 35-59 and to Figure 3 in asserting that the Pack-Harris patent discloses the correlating means. However, amended independent claim 14 recites management means that calculates, aggregates, and causes out-of-pocket costs and sponsor costs to be displayed. The focus is on providing both out-of-pocket costs that a prescription recipient may receive as well as the sponsor costs borne by an employer or other third party payer. With this information, the recipient may evaluate total costs of the particular drug benefit. Similarly, the recipient and sponsor may collaborate to determine the efficacy of the offered prescription drug benefit. The cited portion of the Pack-Harris patent fails to disclose these features recited in amended independent claim 14. Instead, the Pack-Harris patent discloses only the prescription cost of a particular drug. Nowhere does the Pack-Harris patent evaluate and disclose the out-of-pocket costs and sponsor costs of a particular drug benefit.

Likewise, the Mayaud patent fails to cure the deficiencies of the Pack-Harris patent. The Examiner cited the Mayaud patent to allegedly disclose pharmacy benefits formulary information, but the Mayaud patent is an electronic prescribing tool used to improve the quality of prescriptions written (see col. 4, lines 21-26 of the Mayaud patent). While the Mayaud patent discloses in col. 13, lines 49-56 that the data may be aggregated for multiple users and that an individual user's prescribing pattern may be reviewed by the user or by others for formulary compliance, ensuring formulary compliance is not the same as structuring information related to a formulary multi-tier benefits program as recited in the present claims. Further, the environment in which the Mayaud patent may be practiced is not that of a drug benefit recipient or an employer seeking market transparency to control prescription drugs costs, but rather the "user" of the Mayaud patent is a physician or physician group seeking to provide additional details when they prescribe medication.

Further, there is no disclosure in the Mayaud patent of management server means that calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information as recited in amended independent claim 14 of the present application. The present invention brings the consumer of pharmacy benefits into the drug selection process by providing decision support as to the prescribed and available drugs. The pharmacy benefit recipient is at the center of the present invention, and aggregated out-of-pocket costs and sponsor costs are displayed to the recipient of the prescription benefits. In the Mayaud patent, there is no recipient listed as a "user." Instead, physicians and physician groups are the system users.

These features are not disclosed or suggested in either the cited Pack-Harris patent or the Mayaud patent, nor is there any suggestion or motivation to modify the system of the Pack-Harris patent to produce Appellants' system recited in independent claim 14 of the present application.

In the final Office Action mailed April 3, 2008, the Examiner asserts that, "At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Pack-Harris with the teaching of Mayaud to provide/transmit formulary benefits data in a pharmacy system." See first full paragraph on page 5 of the Final Office Action mailed April 3, 2008. Yet, the combination of the Pack-Harris patent with the Mayaud patent fails to disclose or suggest all the features recited in claim 14 of the present application. As such, Appellants respectfully submit that the combination of the Pack-Harris patent and the Mayaud patent fails to disclose or suggest all the elements and limitations

recited in independent claim 14 of the present application and fails to render claim 1 obvious under 35 U.S.C. § 103(a).

The Examiner fails to meet the burden of showing that each and every feature is disclosed by the combination of prior art references, or under 35 U.S.C. § 103(a), that it would have been obvious to combine prior art references to produce the recited claims of the present application. As such, Appellants respectfully submit that the Examiner has not shown that Appellants' invention would have been obvious under 35 U.S.C. § 103(a). Accordingly, Appellants respectfully submit that claim 14 of the present application is allowable over the combination of prior art as outlined above. Appellants respectfully request that the rejection of claim 14 under 35 U.S.C. § 103(a) be reversed.

2. The Rejection of Dependent claims 15-18 and claims 23-26 under 35 U.S.C. § 103(a) should be REVERSED.

Claims 15-18 and claims 23-26 of the present application depend upon independent claim 14 and thereby include all the limitations of claim 1 while reciting additional features of a system of the present invention. Appellants respectfully submit that the rejection of claims 15-18 and claims 23-26 is improper under 35 U.S.C. § 103(a) for similar reasons outlined above with regard to the rejection of claim 14. As discussed above, the combination of cited references fails to disclose or suggest all the elements and limitations recited in independent claim 14 of the present application and fails to render claim 14 obvious under 35 U.S.C. § 103(a). Therefore, the combination of applied references also fails to disclose all the features and limitations of dependent claims 15-18 and claims 23-26, as well, and also fails to render claims 15-18 and claims 23-26 obvious under 35 U.S.C. § 103(a). As such, Appellants respectfully request that the rejection of claims 15-18 and claims 23-26 under 35 U.S.C. § 103(a) be reversed.

3. The Rejection of Independent Claim 27 under 35 U.S.C. § 103(a) should be REVERSED.

Independent claim 27 of the present application recites a pharmacy benefits management method for use in connection with a pharmacy benefits management system. Claim 27 further recites that the pharmacy benefits management method includes the steps of receiving claim information from a pharmacy benefits server, the claim information relating to pharmacy benefits claims processed by a claims processing facility, and the claim information including identification of drugs dispensed to patients. Claim 27 also recites receiving pharmacy benefits formulary information from the pharmacy benefits server, receiving pharmacy benefits plan structure information from a provider server, where the pharmacy benefits plan structure including deductible information and co-payment information.

Claim 27 also recites receiving price information from a management server, the price information relating to drugs in various classes, determining a recipient's prescription benefit plan, and identifying a subscriber of the recipient's prescription benefit plan. The method of claim 27 then calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information.

The method of claim 27 recites aggregating the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug, and causing display of aggregate out-of-pocket costs and sponsor costs to the recipient of prescription benefits.

Independent claim 27 recites a pharmacy benefits management method that is carried out by the system recited in independent claim 14. As such, claims 14 and 27 are related claims that recite a system and method, respectively, for managing pharmacy benefits in accordance with the present invention.

As outlined above with regard to claim 14, the combination of the Pack-Harris patent and the Mayaud patent fails to disclose or suggest all the elements and limitations recited in independent claim 14 of the present application. Similarly, the combination of the Pack-Harris patent and the Mayaud patent also fails to disclose or suggest all the related steps and limitations of independent claim 27 as well. Therefore, Appellants respectfully submit that claim 27 is allowable over the combination of cited references for at least the reasons outlined above with regard to claim 14. Appellants respectfully request that the rejection of claim 27 under 35 U.S.C. § 103(a) be reversed.

4. The Rejection of Dependent claims 28-31 and claims 36-39 under 35 U.S.C. § 103(a) should be REVERSED.

Claims 28-31 and claims 36-39 of the present application depend upon independent claim 27 and thereby include all the limitations of claim 27 while reciting additional features of a method of the present invention. Appellants respectfully submit that the rejection of claims 28-31 and claims 36-39 is improper under 35 U.S.C. § 103(a) for similar reasons outlined above with regard to the rejection of claims 14 and 27. As discussed above, the combination of cited references fails to disclose or suggest all the elements and limitations recited in independent claim 27 of the present application and fails to render claim 27 obvious under 35 U.S.C. § 103(a). Therefore, the combination of applied references also fails to disclose all the features and limitations of dependent claims 28-31 and claims 36-39, as well, and also fails to render claims 28-31 and claims 36-39 obvious under 35 U.S.C. §

103(a). As such, Appellants respectfully request that the rejection of claims 28-31 and claims 36-39 under 35 U.S.C. § 103(a) be reversed.

C. The Rejection of claims 49-51, 53, and 54 as listed on the Office Action Summary Page should be REVERSED

On the Office Action Summary page of the April 3, 2008, Final Office Action, the Examiner lists claims 1-55 as pending in the present application. Of claims 1-55, claims 1-13, 19-22, 32-35, and 40-48 are withdrawn from consideration. The Examiner then lists claims 14-18, 23-31, 36-39, and 49-54 as rejected. As outlined above, in the substantive portion of the final Office Action, the Examiner rejected claims 14-18, 23-31, 36, 37, 52, and 55 under 35 U.S.C. § 112, first paragraph. The Examiner also rejected claims 14-18, 23-31, and 36-39 under 35 U.S.C. § 103(a). No mention is made of claims 49-51, 53, and 54. As such, Appellants respectfully request that the rejection of claims 49-51, 53, and 54 as listed on the Office Action Summary Page should be reversed.

VIII. CONCLUSION

For all of the reasons discussed above, Appellants respectfully submit that all pending claims 14-18, 23-31, 36-39, and 49-55 define patentable subject matter under 35 U.S.C. § 112, first paragraph and 35 U.S.C. § 103(a). Accordingly, Appellants respectfully request this Honorable Board to reverse the rejections of claims 14-18, 23-31, 36-39, and 49-55.

Respectfully submitted,

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IX. CLAIMS APPENDIX

14. A pharmacy benefits management system comprising:

pharmacy benefits means for receiving claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients;

management means for receiving pharmacy benefits formulary information and price information relating to drugs in various classes;

provider means for receiving pharmacy benefits plan structure information including deductible information and co-payment information stored therein to determine a recipient's prescription benefit plan and identify the subscriber of the prescription benefit plan;

said management means further;

calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information;

aggregates the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug; and

causes the aggregated out-of-pocket costs and sponsor costs to be displayed to the recipient of prescription benefits.

15. The system recited in claim 14, wherein the identified drugs dispensed to a patient also indicate the date the drugs were dispensed.

16. The system recited in claim 14, wherein the management means further calculates out-of-pocket costs, sponsor costs, and total costs of alternative drugs, wherein the alternative drugs are therapeutic alternatives with respect to the drugs dispensed to patients.

17. The system recited in claim 14, wherein the benefits plan structure information received from the provider means and the formulary information received from the management means relate to a multi-tier benefits plan.

18. The system recited in claim 17, wherein the out-of-pocket costs, sponsor costs, and total costs associated with the drugs dispensed to patients and the out-of-pocket costs, sponsor costs, and total costs associated with the alternative drugs includes copayment information, sponsor information, and total cost information.

23. The system recited in claim 14, wherein said management means further:

calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients in an alternative pharmacy, wherein the alternative pharmacy is an alternative distribution chain capable of supplying the drugs dispensed to patients; and

aggregates out-of-pocket-costs, sponsor costs and total costs of the drugs based upon the identity of the alternative distribution chain.

24. The system recited in claim 16, wherein said management means further:

calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients and the alternative drugs in an alternative pharmacy, wherein the alternative pharmacy is an alternative distribution chain capable of supplying the drugs dispensed to patients and the alternative drugs; and

aggregates out-of-pocket-costs, sponsor costs and total costs of the drugs dispensed to patients and the alternative drugs based upon the identity of the alternative distribution chain.

25. The system recited in claim 14 further comprising means for entering proposed changes to any of the claim information, the benefit plan structure information, and the formulary information and displaying model data based on the proposed changes.

26. The system recited in claim 25, wherein the proposed changes comprise any of changes to copayment amounts, changes to copayment levels, and changes drugs dispensed.

27. A pharmacy benefits management method comprising the steps of:

receiving claim information from a pharmacy benefits server, the claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients;

receiving pharmacy benefits formulary information from the pharmacy benefits server;

receiving pharmacy benefits plan structure information from a provider server, the pharmacy benefits plan structure including deductible information and co-payment information;

receiving price information from a management server, the price information relating to drugs in various classes;

determining a recipient's prescription benefit plan;

identifying a subscriber of the recipient's prescription benefit plan;

calculating out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information;

aggregating the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug;

causing display of aggregate out-of-pocket costs and sponsor costs to the recipient of prescription benefits.

28. A method as recited in claim 27, wherein the drugs dispensed to patients in said calculating step are drugs previously dispensed to a patient indicated by the date the selected drugs were dispensed.

29. A method as recited in claim 27, wherein the calculating step includes calculating out-of-pocket costs, sponsor costs, and total costs of alternative drugs, wherein the alternative drugs are therapeutic alternatives with respect to the drugs dispensed to patients.

30. A method as recited in claim 27, wherein the benefits plan structure information and the formulary information relate to a multi-tier benefits plan.

31. A method as recited in claim 30, wherein the out-of-pocket costs, sponsor costs, and total costs associated with the drugs dispensed to patients and the out-of-pocket costs, sponsor costs, and total costs associated with the alternative drugs includes copayment information, sponsor information, and total cost information.

36. A method as recited in claim 27, wherein;

the calculating step includes calculating out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients in an alternative pharmacy, wherein the alternative pharmacy is an alternative distribution chain capable of supplying the drugs dispensed to patients; and

the aggregating step includes aggregating out-of-pocket-costs, sponsor costs and total costs of the drugs based upon the identity of the alternative distribution chain.

37. A method as recited in claim 29, wherein

the calculating step includes calculating out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients and the alternative drugs in an alternative pharmacy, wherein the alternative pharmacy is an alternative distribution chain capable of supplying the drugs dispensed to patients and the alternative drugs, and

the aggregating step includes aggregating out-of-pocket-costs, sponsor costs and total costs of the drugs dispensed to patients and the alternative drugs based upon the identity of the alternative distribution chain.

38. A method as recited in claim 27 further comprising:

entering proposed changes to any of the claim information, the benefit plan structure information, and the formulary information; and

displaying model data based on the proposed changes.

39. A method as recited in claim 38, wherein the proposed changes comprise any of changes to copayment amounts, changes to copayment levels, and changes to drugs dispensed.

49. The method recited in claim 27, further comprising displaying aggregate out-of-pocket costs and sponsor costs to the sponsor of prescription benefits.

50. The method recited in claim 27, further comprising receiving a second set of claim information from a second pharmacy benefits server, the second set of claim information relating to pharmacy benefits claims processed by a second claims processing facility, and the second set of claim information including identification of drugs dispensed to patients.

51. The method recited in claim 50, wherein the calculating step includes calculating out-of-pocket costs, sponsor costs, and total costs of alternative drugs ,wherein the alternative drugs are therapeutic alternatives with respect to the drugs dispensed to patients.

52. The method recited in claim 51, wherein the calculating step includes calculating out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients and the alternative drugs in an alternative pharmacy, wherein the alternative pharmacy is an alternative distribution chain capable of supplying the drugs dispensed to patients and the alternative drugs; and

the aggregating step includes aggregating out-of-pocket-costs, sponsor costs and total costs of the drugs dispensed to patients and the alternative drugs based upon the identity of the alternative distribution chain.

53. The system recited in claim 14, further comprising a second pharmacy benefits means for receiving a second set of claim information, the second set of claim information relating to pharmacy benefits claims processed by a second claims processing facility, and the second set of claim information including identification of drugs dispensed to patients.

54. The system recited in claim 53, wherein said management means further calculates out-of-pocket costs, sponsor costs, and total costs of alternative drugs ,wherein the alternative drugs are therapeutic alternatives with respect to the drugs dispensed to patients.

55. The system recited in claim 54, wherein said management means further calculates out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients and the alternative drugs in an alternative pharmacy, wherein the alternative pharmacy is an alternative distribution chain capable of supplying the drugs dispensed to patients and the alternative drugs; and

said management means further aggregates out-of-pocket-costs, sponsor costs and total costs of the drugs dispensed to patients and the alternative drugs based upon the identity of the alternative distribution chain.

X. EVIDENCE APPENDIX

There is no additional evidence related to this Appeal.

XI. RELATED PROCEEDINGS APPENDIX

There are no related proceedings to this Appeal.